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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/918,541	08/01/2001	Gary Mishkin	MISHKIN=1	3823
1444	7590	02/18/2004	EXAMINER	
BROWDY AND NEIMARK, P.L.L.C. 624 NINTH STREET, NW SUITE 300 WASHINGTON, DC 20001-5303			PERRIN, JOSEPH L	
			ART UNIT	PAPER NUMBER
			1746	

DATE MAILED: 02/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/918,541

Applicant(s)

MISHKIN ET AL.

Examiner

Joseph L. Perrin, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. In view of applicant's amendment filed 07 January 2004 the status of the application is as follows:

35 U.S.C. §102(b) Rejections over Arnal et al. (hereinafter "Arnal")

The rejection of claims 1-5, 7-8, 10-12 & 14 are maintained for at least reasons set forth below.

In response to applicant's argument that Arnal does not disclose the needle being movable between two distinctive positions, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

In the instant case, applicant admits that Arnal (see Arnal, col. 11, lines 23-38) discloses fluid pressure to force the needle from a distinct first position to a distinct extended second position (see page 10 of the instant Response). Thus, since Arnal's needle is capable of being moved between two distinct positions, as claimed by applicant, the recitation of Arnal structurally reads on applicant's claimed device. Moreover, applicant's arguments directed to the

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operation of the device during cleaning is considered intended use and given little patentable weight. Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).

35 U.S.C. §103(a) Rejections over Arnal

The rejection of claims 6, 9 & 13 are maintained for at least reasons set forth below.

Applicant argues:

The rejection presented in section 6 [rejection under 35 USC §103(a)] of the action is traversed on the grounds that the rejected claims should be considered allowable along with the claims from which they depend.

This is not persuasive because the rejection of these claims and the claims from which they depend are maintained for reasons of record.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1-5, 7-8, 10-12 & 14 are rejected under 35 U.S.C. 102(b) as being anticipated by US 6,050,278 to Arnal *et al.* (hereinafter “Arnal”).

Re claims 1, 10 & 14, Arnal discloses a dialyzer head cleaning apparatus 10 including a housing 14 with opposed ends and delimiting passage 24, a connecting element 50 at one end of the housing, a rotatable and retractable flow directing element 38 with fluid outlets 28 capable of operating as a extending, rotary fluid discharge reaction nozzle (see entire reference of Arnal, for instance, Figures 1A, 2 & 6; col. 8, line 46 *et seq.*; and col. 11, lines 34-44).

Re claims 2, 7-8 & 11-12, Arnal discloses the flow passage 46 in the housing 14, and the needle as being tapered as claimed (for instance, Figures 1A & 4A).

Re claims 3-5, Arnal discloses the needle having a circular wall with outlet openings tangential to the outer wall, and formations (fins) causing rotation of the nozzle (reaction discharge nozzles, well known in the cleaning arts) (see, for instance, Figures 4A-B; col. 11, lines 41-44).

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 6, 9 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnal as cited above.

Recitation of Arnal is repeated here from above. Arnal further discloses the needle inlet 16 having an opening (for instance, col. 11, lines 8-10). Although

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Arnal does not expressly disclose the needle inlet as having more than one opening, Arnal does disclose the outlet having multiple openings (as previously cited). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the inlet with more than one opening (as in the outlet) for improved/enhanced fluid flow, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 167.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
7. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph L. Perrin, Ph.D. whose telephone number is

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(571)272-1305. The examiner can normally be reached on M-F 7:00-4:30, except alternate Fridays.

9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on (571)272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph L. Perrin, Ph.D.
Examiner
Art Unit 1746

jlj


FRANKIE L. STINSON
PRIMARY EXAMINER
GROUP 3400-1700